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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,798	08/28/2003	Hirokazu Arai	AI 304	5608
23995	7590	11/15/2006	EXAMINER	
RABIN & Berdo, PC 1101 14TH STREET, NW SUITE 500 WASHINGTON, DC 20005			POULOS, SANDRA K	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,798

Applicant(s)

ARAI ET AL.

Examiner

Sandra K. Poulos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/02/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections and objections except for those described below are overcome by applicant's amendment filed 8/29/06.

The new grounds of rejection set forth below are necessitated by applicant's amendment filed 8/29/06. In particular, claim 1 has been amended such that the amount of inorganic powder is limited to 20 to 50 % wherein this different range introduces new matter. Therefore the following action is properly made **FINAL**.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 and 4-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 now recites the new range "20 to 50 % by weight of an inorganic powder." It is the examiner's position that this phrase fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the endpoint 20% in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

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Applicant has pointed to examples 1-3 for support, however, there is only support for 20% for spherical silica powder with an average particle diameter of 20 micron and a Mohs hardness of 7~8, and not support for the entire range of inorganic powders.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asai (US 2002/0123557) in view of Isutsumi (US 5,514,748) and The Handbook of Fillers.

Asai discloses a phenolic molding composition containing 40 to 100 parts inorganic fiber such as glass fiber (col 2, line 55; examples), 20 to 90 parts silica powder with an average particle diameter of from 20 to 150 micron, and 1 to 15 parts rubber component per 100 parts phenolic resin. The above amounts were calculated as the following ranges: 16-43 wt% inorganic fiber, 12-39 wt% silica, 0.3-8% rubber, and 33-59 wt% phenolic resin. The phenolic resin has an average molecular weight of 600 to 800 (col 2, lines 19-22). The silica is a round grain type (col 3, lines 9). The Handbook of Fillers discloses the hardness of silica between 6 to 7 (pg 287). The molding composition is used as a pulley material (col 6, lines 33-39). Asai discloses that various kinds of additives commonly used in phenolic molding compositions may be used (col 3, lines 31-38).

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Asai does not disclose 1-5 wt% of a fluoro-resin lubricant with an average diameter of not more than 10 micron and not less than 1 micron.

Isutsumi discloses a molding resin contained phenolic resin (col 18, lines 16-67), fibrous filler (col 21, line 59 to col 22, line 62), and 3 to 14 parts PTFE for improving wear resistance (col 19 line 1 to col 21 line 58). The PTFE has low friction features and has a particle size of 5 to 10 μm (col 19 line 51 to col 21 line 58). At the defined particle size the PTFE has "outstanding" properties (col 20, line 39). The composition is open to other materials including silica and alumina (col 19, lines 16-28).

It would have been obvious to one of ordinary skill in the art to use 3 to 14 parts PTFE that has a particle size of 5-10 μm in the composition disclosed by Asai (resulting in 1-8 wt% PTFE) because of the improved properties as disclosed by Isutsumi, such as improved sliding properties of the matrix resin (col 19, lines 1-8).

Response to Arguments

4. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. The previous rejections have been withdrawn in view of the amended range for inorganic powder because the prior references taught at most 15% inorganic powder, which is no longer claimed. With regard to the above combination, examiner's response to arguments set forth in paragraph 6 of the previous Office Action dated 3/29/06 is incorporated by reference.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra K. Poulos whose telephone number is (571) 272-6428. The examiner can normally be reached on M-F 8:00-4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SK

Sandra K. Poulos

Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700